

REMARKS

Applicant thanks the Examiner for discussing this application with Applicant's undersigned representative during a telephonic interview on May 4, 2007.

By this amendment, Applicant proposes to cancel claims 33 and 46, and incorporate the subject matter thereof into their respective independent claims 31 and 44. Applicant further proposes amending claims 57 and 58. Upon entry of this amendment, claims 31, 32, 34-45, and 47-58 will remain pending in this application.

In the Office Action,¹ the Examiner took the following actions:

(1) rejected claims 31, 32, 39, and 42 under 35 U.S.C. § 103(a) as being unpatentable over E-Benefits Inc. website ("*E-Benefits*") in view of U.S. Patent Application Publication No. 2002/0049642 to Moderegger et al. ("*Moderegger*");

(2) rejected claim 33 under 35 U.S.C. § 103(a) as being unpatentable over *E-Benefits* in view of *Moderegger* and further in view of U.S. Patent Application Publication No. 2002/0023212 to Proudler ("*Proudler*");

(3) rejected claims 34-36 under 35 U.S.C. § 103(a) as being unpatentable over *E-Benefits* in view of *Moderegger* and further in view of MacSweeny, Gregory, "Billing System Drives Cross-Sell Efforts," Insurance & Technology, June 2003, Vol. 28, Issue 6, p. 23 ("*MacSweeny*");

(4) rejected claims 37 and 38 under 35 U.S.C. § 103(a) as being unpatentable over *E-Benefits* in view of *Moderegger* and *MacSweeny* further in view of Singerman,

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statements or characterization in the Office Action.

Frederic S., "The Impact of the Electronic Signatures Act on Plan Administration,"
Journal of Pension Benefits: Issues in Administration, Autumn 2000, Vol. 8, Issue 1,
pp. 3-8 ("*Singerman*");

(5) rejected claims 40 and 41 under 35 U.S.C. § 103(a) as being unpatentable
over *E-Benefits* in view of *Moderegger* and further in view of U.S. Patent Application
Publication No. 2003/0229522 to Thompson et al. ("*Thompson*");

(6) rejected claim 43 under 35 U.S.C. § 103(a) as being unpatentable over
E-Benefits in view of *Moderegger* and further in view of Tomsen, Mai-lan, "Killer
Content: Strategies for Web Content and E-Commerce," Addison Wesley Longman,
Inc., Reading, Massachusetts, April, 2000, pp. 13, 129-133, and 177-180 ("*Tomsen*");
and

(7) rejected claims 44-58 for substantially the same reasons as provided above
for claims 31-43.

Applicant respectfully traverses all of the 35 U.S.C. § 103 rejections in the Final
Office Action because a *prima facie* case of obviousness has not been established for
reasons set forth below.

To establish a *prima facie* case of obviousness, the prior art reference (or
references when combined) must teach or suggest all the claim limitations. See
M.P.E.P. § 2142, 8th Ed., Rev. 5 (August 2006). Moreover, "in formulating a rejection
under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains
necessary to identify the reason why a person of ordinary skill in the art would have
combined the prior art elements in the manner claimed." USPTO Memorandum from

Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007,
page 2.

A *prima facie* case of obviousness has not been established because, among other things, none of the cited references, taken alone or in any proper combination, teach or suggest each and every element of Applicant's claims.

Independent claim 31 recites a combination of features including, for example, "the contract document includes a status of at least one of accepted, rejected, and amended." The Examiner acknowledges the primary reference, *E-Benefits*, fails to disclose much of the elements of claim 31, including the above-quoted feature of providing a "status" in the "contract document." See Office Action, pp. 4-5. However, the Examiner argues that paragraphs 0036 and 0057 of *Moderegger* disclose the above-quoted feature of claim 31. See Office Action, p. 5. Applicant respectfully disagrees.

The Examiner apparently considers the "contract" of *Moderegger* to correspond to Applicant's "contract document" recited in claim 31. See Office Action, p. 4. The Examiner further considers *Moderegger's* "awarding of a contract" and the statement that the "contract has been awarded" as a teaching of "a status of . . . accepted," as recited in claim 31. See Office Action, p. 5. Assuming *arguendo* that the Examiner's characterization of *Moderegger* is correct, which Applicant does not concede, *Moderegger* does not teach that "the contract document includes a status," as recited in claim 31 (emphasis added).

Moderegger teaches that “the bid prices . . . that were accepted in the awarding of a contract . . . [are] loaded onto the database.” *Moderegger*, para. 0036.

Furthermore, the database in *Moderegger* contains a “price description field [which] includes . . . whether the bid was accepted.” *Moderegger*, para. 0036. This is the opposite of what is being claimed, and *Moderegger* clearly does not teach or suggest that the “status” (e.g., such as accepted) is included in the “contract document” itself. Therefore, *Moderegger* fails to teach or suggest “the contract document includes a status of at least one of accepted, rejected, and amended,” as recited in claim 31 (emphasis added). Accordingly, *Moderegger* does not cure the deficiencies of *E-Benefits*, and *E-Benefits* and *Moderegger*, taken alone or in any proper combination, fail to teach or suggest all of the elements of claim 31, including that “the contract document includes a status of at least one of accepted, rejected, and amended.”

Independent claim 31, as amended, further recites “wherein if the received contract document includes the status of rejected, then automatically selecting a next best bid from the received bids based on the sorting, and repeating the automatically transmitting and automatically receiving the contract document steps with the next best bid.” The Examiner argues that *Proudler* teaches the above-quoted features of claim 31, which were recited in canceled claim 33 before this amendment. See Office Action, p. 7. Applicant respectfully disagrees.

Although *Proudler* may teach rejecting a contract, as the Examiner alleges, *Proudler* does not teach or suggest “automatically selecting the next best bid from the received bids,” as recited in claim 31. *Proudler* also fails to overcome the other noted

deficiencies of *E-Benefits* and *Moderegger*, including with respect to at least providing a “status” in the “contract document.”

The Examiner argues that “repeating the automatically transmitting and automatically receiving the contract document steps with the next best bid,” as recited in claim 31, is obvious as duplication of steps in view of *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). However, the Examiner misapplies *In re Harza* to the present claims. First, *In re Harza* applies to duplication of parts, not duplication of functions or steps. Second, the above-quoted recitation of claim 31 is not mere duplication of steps. The first transmitting and receiving steps occur with the best bid. The second (and subsequent) transmitting and receiving steps occur with the next best bid. Accordingly, these steps are distinct and are not mere duplications. Moreover, “automatically selecting the next best bid from the received bids,” is a step that did not occur before and, therefore, is not a repeat or duplication of a previous step.

Therefore, for at least the reasons set forth above, *E-Benefits*, *Moderegger*, and *Proudlar*, taken alone or in any proper combination, fail to teach or suggest each and every element of claim 31. Therefore a *prima facie* case of obviousness has not been established with respect to claim 31.

Independent claims 44, 57, and 58, although different in scope, include one or more recitations similar to those discussed above in claim 31. Accordingly, claims 44, 57, and 58 are also allowable for at least reasons similar to those given above with respect to claim 31. Furthermore, dependent claims 32, 34-43, 45, and 47-56 are also allowable at least by virtue of their dependence from allowable base claims 31 and 44,

and because other the cited references, *MacSweeny*, *Singerman*, *Thompson*, and *Tomsen*, fail to cure the above-discussed deficiencies of *E-Benefits*, *Moderegger*, and *Proudlar*.

Accordingly, Applicant respectfully requests that the Examiner withdraw all of the rejections and allow pending claims 31, 32, 34-45, and 47-58.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of all pending claims.

Applicant respectfully requests that the Examiner enter this Amendment under 37 C.F.R. § 1.116, placing claims 31, 32, 34-45, and 47-58 in condition for allowance. Applicant submits that the proposed amendments of claims 31, 44, 57, and 58 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicant respectfully points out that the Final Office Action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow the Applicant to reply to the final rejections and place the application in condition for allowance.

Finally, Applicant submits that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: May 9, 2007

By: 

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